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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/630,425

07/30/2003

Hubert Carl Burton JR.

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06/19/2006

NELSON MULLINS RILEY & SCARBOROUGH, LLP
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EXAMINER

SEMBER, THOMAS M

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,425

Applicant(s)

HERBERT CARL BURTON, JR.

Examiner

Thomas M. Sember

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 1,3-17,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on 03/28/06. These drawings are approved.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-9, 11-17 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoover et al '72. Hoover et al '72 discloses a light housing 10 for at least partially shielding a light source 80. A shield having a rear wall 18 is located posterior to a rear portion of the light source, wherein the shield wall light source has an emitting portion located opposite the rear portion, and wherein the shield rear wall has a top edge 14 and a bottom edge 20, and the shield is separate from the light source and is adapted to partially enclose but not contact the light source and at least one attachment arm (pole attachment in figure 1) for attaching the shield to a fixed object.

Regarding claim 3, the rear wall has a semi-circular shape.

Regarding claim 4, the shield further comprises at least one sidewall.

Regarding claim 5, the shield comprising two sidewalls, wherein the two sidewalls are curved and the rear wall has a semi-circular shape.

Regarding claim 6, the curved sidewalls extend from the semi-circular rear wall at substantially the same radius as the semi-circular rear wall so that the two curved sidewalls are contiguous with the semi-circular rear wall and together form a uniform semi-circular shape.

Regarding claims 7-8, an aperture 55 in the rear wall of the shield 10, wherein the aperture 55 is contiguous with the bottom edge of the rear wall.

Regarding claim 9, the shield further comprises a top that is attached to the top edge and at least partially covers that portion of the shield, which encloses the light source.

Regarding claim 11, the attachment arm is attached to the shield at the bottom edge of the rear wall.

Regarding claim 12 the attachment arm is a unitary construction contiguous with the shield (regarding the limitation of "injection molding", applicant is reminded that disclosure of only a method of making the invention and the function may not be sufficient to support a product claim other than a product-by-process claim). Thus, since Panagiotou shows an attachment arm unitary with shield, the prior art reference of Panagiotou meets this claim.

Regarding claim 13, the attachment arm comprises one or more devices selected from the group consisting of glue, screws, clamps, staples, nails, stakes, screws, clamps, tie downs, Velcro®, tape, wire ties, buttons, snaps, weights, hooks, metal rods, or magnetic attachments.

Regarding claim 14, the attachment arm includes a stake 62.

Art Unit: 2875

Regarding claim 15, the attachment arm is made from a material selected from the group consisting of steel, stainless steel, aluminum alloys, iron alloys, thermoplastic polymers, thermoset polymers, and cellulosic materials.

Regarding claim 16, the rear wall is constructed from a material selected from the group consisting of metal, plastic, composite material, and cellulosic material.

Regarding claim 17, the rear wall comprises a reflective material.

Regarding claim 21, an aperture 55 in the rear wall of the shield 10, wherein the aperture 55 is contiguous with the bottom edge of the rear wall.

2. The indicated allowability of claim 10 is withdrawn in view of reconsideration of Hoover et al '72 in view of case law.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoover et al '72. Hoover et al '72 discloses the claimed invention except for the teaching that wherein the top of the shield is flat and extends perpendicularly at a 90 angle from the rear wall. It would have been an obvious engineering design choice to modify the top of

Art Unit: 2875

the shield to be flat since applicant has failed to disclose any advantage, persuasive evidence or unexpected result obtained in making the top edge of the shield flat and it appears the shield of Hoover et al '72 would perform equally well at shielding light and directing it forward. See also case law regarding changes in shape, particularly In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) where The court held that " the configuration of the claimed disposable plastic nursing container was a matter of design choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant."

Allowable Subject Matter

5. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claim 19 is allowed.

Response to Arguments

Applicant's arguments filed on 03/28/06 with regards to the Hoover et al '72 reference has been fully considered but is not found persuasive. Applicant argues that Hoover et al '72 fails to teach to "the shield is separate from the light source and is adapted to partially enclose but not contact the light source" as now claimed in

Art Unit: 2875

applicant's independent claim 1. The examiner disagrees. The light source 80 of Hoover et al '72 does not contact the shield/housing 10 but instead contacts socket 53 which is held by shield/housing 10. The applicant further states that the light housing of Hoover et al '72 is in "operable communication" with the light source. This argument is not persuasive, as broadly claimed the shield 10 of Hoover et al '72 is separate from the light source 80 and is adapted to partially enclose but not contact the light source 80. Finally, applicant argues that Hoover et al '72 fails to teach an aperture as claimed in independent claim 21. The examiner disagrees. Hoover et al '72 teaches "an aperture 55 in the rear wall of the shield 10, wherein the aperture 55 is contiguous with the bottom edge of the rear wall."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is 571-272-2381. The examiner can normally be reached on M-F 8 A.M- 5.30 p.m. first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2875

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'T. M. Sember', with a long, sweeping horizontal stroke extending to the right.

Thomas M Sember
Primary Examiner
Art Unit 2875